

Remarks

The Office Action dated April 20, 2005, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-18 are currently pending in the present application.

Claims 1, 2, 4, 7-14, 17 and 18 Rejected under 35 U.S.C. § 103(a)

Claims 1, 2, 4, 7-14, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yatsuda et al., (U.S. Patent Publication No. 2002/0003459, hereinafter "Yatsuda"). Applicant respectfully traverses the rejection and submits that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

Claim 1 recites a surface acoustic wave device comprising, among other features, a flexible chip mounting base that has a first surface on which the surface acoustic wave filter is mounted and has a thickness equal to or less than 100 μm .

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicant's invention.

In making the rejection, the Examiner characterized Yatsuda as allegedly disclosing "a surface acoustic wave (SAW) device ...[H]owever, Yatsuda is silent regarding the thickness of the mounting base being equal to or less than 100 μm ."

Applicant respectfully disagrees with the Examiner's characterization of Yatsuda and submits that Yatsuda fails to disclose or suggest each and every element recited in claim 1 of the present application. It is also submitted that the surface acoustic wave device and method of producing the same of Yatsuda is neither comparable nor analogous to the surface acoustic wave device of the present invention.

As a preliminary matter, Applicants submits that the rejection of claim 1 is improper since the rejection fails to fully and clearly set forth the ground of the rejection. MPEP § 707.07(d) states that “where a claim is refused for any reason relating to the merits thereof, it should be ‘rejected’ and the ground of rejection fully and clearly stated.” (Emphasis added.) In other words, it is submitted that the rejection of claim 1 fails to fully and clearly state the ground of rejection because the rejection failed to address the limitation of “a flexible chip mounting base that has a first surface on which the surface acoustic wave filter is mounted” as recited in claim 1. As such, applicant submits that the Office Action issued April 20, 2005 is unclear and incomplete, and therefore fails to comply with 37 C.F.R. § 1.104(b) of the US patent practice.

Furthermore, Applicant submits that Yatsuda fails to disclose or suggest at least the limitation of “a flexible chip mounting base that has a first surface on which the surface acoustic wave filter is mounted” as recited in claim 1. The present invention, in one embodiment, discloses a flexible chip mounting base 21 that can reduce stress applied to the interfaces between a SAW filter chip 1 and the package. Accordingly, even when the flexible chip mounting base 21 is deformed, a connection failure can be avoided which provides for a SAW device 1 that has high mounting reliability according the one embodiment of the present invention.

In contrast, Yatsuda fails to disclose or suggest the flexibility of the bottom layer on which the chip 10 is mounted and the thickness of the mounting base. In fact, Applicant submits that Yatsuda neither addresses nor considers the flexibility of the bottom layer of the package and the bottom layer is rigid and non-flexible. It is further

submitted that those skilled in the art would NOT select a thickness that makes the mounting base flexible.

Moreover, the Examiner states that the second cavity of the claimed invention corresponds to a window 12e. Applicant respectfully disagrees with this characterization of Yatsuda. The window 12e of Yatsuda is spatially continuous to the cavity in which the chip 10 is mounted. The lower surface of the bottom layer of the package of Yatsuda is not exposed via the window 12e. In other words, Yatsuda does not have any cavity via which the lower surface of the bottom layer base is exposed.

Given the above, Applicant submits that Yatsuda fails to disclose each and every element recited in claim 1 of the present application.

In order to establish a *prima facie* case of obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and In re Royka, 490 F.2d 981 (CCPA 1974). As explained above, Yatsuda fails to teach or suggest each feature recited by pending claim 1. Accordingly, for the above provided reasons, Applicant respectfully submits that pending claim 1 is not rendered obvious under 35 U.S.C. § 103 by the teachings of Yatsuda.

As claims 2, 4, 7-14, 17 and 18 depend from claim 1, Applicant submits that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

Applicant respectfully requests withdrawal of the rejection.

Claims 5 and 6 Rejected under 35 U.S.C. § 103

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yatsuda in view of Misawa (EP 1076414). Applicant respectfully traverses the rejection and submits that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

Yatsuda is discussed above.

Misawa is applied for allegedly teaching the second cavity having a size larger than the size of the SAW filter.

Applicant submits that Misawa fails to overcome the above-mentioned drawbacks of Yatsuda.

As claims 5 and 6 depend from claim 1, Applicant submits that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

Applicant respectfully requests withdrawal of the rejection.

Claims 15 and 16 Rejected under 35 U.S.C. § 103

Claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yatsuda. Applicant respectfully traverses the rejection and submits that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

As claims 15 and 16 depend from claim 1, Applicant submits that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at

least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

Applicant respectfully requests withdrawal of the rejection.

Conclusion

In view of the above, Applicant respectfully submits that each of claims 1-18 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicant also submits that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully request that claims 1-18 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time.

Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing docket number 025720-00022.

Respectfully submitted,



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